

REMARKS

Claims 11-12 have been amended to improve the form only. Claims 1-4, 9, and 11-12 are pending and under consideration. This amendment is believed to place the application in condition for allowance, and entry therefore is respectfully requested. In the alternative, entry of this amendment is requested as placing the application in better condition for appeal by, at least, reducing the number of issues outstanding.

Entry of Amendment under 37 C.F.R. § 1.116

The Applicant requests entry of this Rule 116 Response because: Examiner has newly cited a reference not previously made of record in rejecting the claims; and the amendment does not significantly alter the scope of the claims and places the application at least into a better form for purposes of appeal. No new features or new issues are being raised.

The Manual of Patent Examining Procedures (M.P.E.P.) sets forth in Section 714.12 that “any amendment that would place the case either in condition for allowance or in better form for appeal may be entered.” Moreover, Section 714.13 sets forth that “the Proposed Amendment should be given sufficient consideration to determine whether the claims are in condition for allowance and/or whether the issues on appeal are simplified.” The M.P.E.P. further articulates that the reason for any non-entry should be explained expressly in the Advisory Action.

I. Claim Objections

In the Office Action, at page 2, claims 11 and 12 were objected to as being of improper dependent form. Claims 11 and 12 have been amended in response to the objection. Accordingly, withdrawal of the objection is respectfully requested and it is submitted that claims 11-12 are in a condition suitable for allowance.

II. Rejections under 35 U.S.C. § 102

In the Office Action, at pages 2-3, claims 1-2 were rejected under 35 U.S.C. § 102(b) as being anticipated by newly-cited Watanabe et al. (JP 5-102254).

Watanabe et al. does not discuss or suggest “wire bonding connection pads at peripheral regions, surrounding an inside region, of an electrode terminal formation surface of a semiconductor chip,” as recited in claim 1. The Examiner indicates that Watanabe et al. discloses a semiconductor device (Figs. 1-2) having wire bonding connection pads 6. However, this is submitted to be incorrect. The pads 6 of Watanabe et al. are actually tester contact pads, which do not correspond to the wire bonding connection pads that are provided on the electrode

formation surface of the semiconductor device of claim 1. The device disclosed in Watanabe et al. is a device for probe testing a semiconductor chip 3, in which a probe 10 extended from a probe card 1 having the tester contact pads 6 is brought into contact with electrodes 11 of the semiconductor device 3. The probe card 1 does not form part of the semiconductor chip 3, but instead forms a separate body (Watanabe et al., Figs. 1-3). In contrast, the invention of claim 1 provides for wire bonding connection pads 22 to be on an electrode terminal formation surface of a semiconductor chip 10. Thus, the device of Watanabe et al. does not disclose all of the features of the invention of claim 1.

Since Watanabe et al. does not discuss or suggest all of the features recited in claim 1, claim 1 patentably distinguishes over the reference relied upon. Accordingly, withdrawal of the § 102(b) rejection is respectfully requested.

Claim 2 depends directly from claim 1, and includes all the features of claim 1, plus additional features that are not discussed or suggested by the reference relied upon. Therefore, claim 2 patentably distinguishes over the reference relied upon for at least the reasons noted above. Accordingly, withdrawal of the § 102(b) rejection is respectfully requested.

III. Allowable Subject Matter

In the Office Action, at page 3, claims 3-4 and 9 were objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

As discussed above, none of the cited prior art discusses or suggests all of the features of claim 1, so that claim 1 patentably distinguishes over the cited prior art. Claims 3-4 and 9 depend either directly or indirectly from claim 1, and include all the features of claim 1, plus additional features that have been acknowledged as patentable by the Examiner. Accordingly, withdrawal of the objection is respectfully requested and it is submitted that claims 3-4 and 9 are in a condition suitable for allowance.

CONCLUSION

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

Docket No. 300.1180

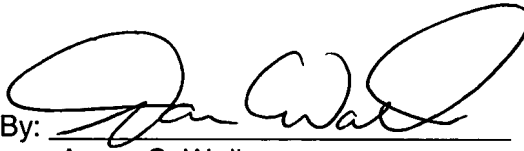
Serial No. 10/521,195

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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